REMARKS

This amendment is being filed in response to the Office Action having a mailing date of May 15, 2006. Claims 1-4 and 9-12 are canceled herein without prejudice. Claim 5 is rewritten in independent form, and claim 6 is rewritten to include the recitations of its former base dependent claims 4 and 2. Claims 17-18 are amended to clarify that these claims and their dependent claims do not fall within the scope of 35 U.S.C. § 112, sixth paragraph. New claim 21 has been added. No new matter has been added. With this amendment, claims 5-8, and 13-21 are pending in the application. Reconsideration of the allowability of the pending claims of present application is respectfully requested.

I. Rejections under 35 U.S.C. § 112, second paragraph

In paragraph 2, the Office Action rejected claims 1-16 as being indefinite. Specifically, the Office Action stated that claims 1-16 should indicate that "when irradiated the two recording layers undergo mixing in the same manner as recited in claims 17."

The applicants respectfully disagree with this rejection. The "mixing" feature is a recitation in the method of claim 17, and may be optionally present or not present in the optical recording medium structure recited in claims 1-16. In short, the structure of the optical recording medium of claims 1-16 can be provided without necessarily incorporating the "mixing" feature. A person skilled in the art having the benefit of this disclosure can also recognize that the "mixing" feature is not required in claims 1-16 in order to make such claims definite. Therefore, it is kindly requested that the indefiniteness rejections be withdrawn.

New claim 21 is being presented herein that explicitly recites the "mixing" feature. Claim 21 is dependent on claim 5, thereby making claim 5 more definite under 35 U.S.C. § 112, second paragraph.

II. Rejections under 35 U.S.C. §§ 102 and 103

A. Claims 1-4 and 9-12 are canceled herein

In paragraphs 5-12, the Office Action rejected some or all of claims 1-4 and 9-12 as being unpatentable under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) in single or combined view of:

Patent App. No. JP 59-225992 to Shigeta *et al.* (hereafter "***Shigeta '992***");

Patent No. US 6,210,860 to Fukano *et al.* (hereafter "***Fukano'860***");

Patent App. No. JP 62-028941 to Okawa *et al.* (hereafter "***Okawa '941***");

Patent App. No. JP 60-160036 to Takoaka *et al.* (hereafter "***Takoaka '036***");

Patent App. No. JP 57-027788 to Masabumi *et al.* (hereafter "***Masabumi '788***");

Patent App. No. US 2001/0021160 to Shuy *et al.* (hereafter "***Shuy '160***");

Patent No. US 4,477,819 to Lee *et al.* (hereafter "***Lee '819***"); and

Patent App. No. US 2001/0044073 to Fukano *et al.* (hereafter "***Fukano '073***").

The applicants have canceled claims 1-4 and 9-12 herein without prejudice, thereby rendering the above-rejections moot.

B. Claims 5-8 and 13-16 are allowable

Claims 5-8 and 13-16 were not rejected as anticipated by or obvious over the various references listed above, whether singly or in combination. Therefore, claims 5-8 and 13-16 would be (are) allowable over these references.

Accordingly, claim 5 has been rewritten into independent form by including the general recitations of its canceled base claims 1 and 3. The general recitations of canceled claims 2 and 4 area now included in rewritten dependent claim 6, which is now dependent on newly independent claim 5. None of the cited references disclose, teach, or suggest to one skilled in the art the subject matter recited in claims 5 and 6. Accordingly, independent claim 5 and dependent claims 6-8 and 13-16 are allowable over the references listed above that have been cited in the Office Action.

It is respectfully submitted that claims 5-8 and 13-16 are also allowable over the two *Inoue* references, as will be explained below.

C. Inoue '080 and Inoue '825 are not prior art for purposes of 35 U.S.C. § 103(a)

In paragraph 13 of the Office Action, claims 1-20 were rejected as unpatentable under 35 U.S.C. § 103(a) or U.S. Patent Application Publication No. 2006/0078825 to Inoue *et al.* (hereafter "*Inoue '825*") and U.S. Patent Application Publication No. 2004/0038080 to Inoue *et al.* (hereafter "*Inoue '080*"). The applicants respectfully point out that *Inoue '080* was filed in the U.S. on **June 27, 2003** and *Inoue '825* is a divisional application of *Inoue '080* (filed on November 7, 2005) and thus also has a domestic priority date of **June 27, 2003**.

The applicants further point out that the present application was filed in the U.S. on August 7, 2003 and claimed priority to Japanese Patent Application No. 2002-234281 filed on **August 12, 2002**. This August 12, 2002 foreign priority date precedes the June 27, 2003 U.S. filing dates of *Inoue '825* and *Inoue '080*. In accordance with established U.S. patent law and U.S. Patent Office practice, the foreign filing dates of *Inoue '825* and *Inoue '080* are irrelevant for purposes of using these documents as references. Therefore, *Inoue '825* and *Inoue '080* do not qualify as prior art under 35 U.S.C. § 103(a) or other provision.

An English-language translation of the priority Japanese Patent Application No. 2002-234281, as well as the requisite signed statement by a translator conversant in the English and Japanese languages, are being filed along with this amendment. With the filing of these documents, it is kindly requested that the grounds for rejecting claims 1-20 on the basis of *Inoue '825* and *Inoue '080* be withdrawn, and that claims 5-8 and 13-20 be allowed.

III. Non-Statutory Obviousness-Type Double Patenting

In paragraph 14-18 of the Office Action, claims 1-20 stand provisionally rejected under the doctrine of judicially created obviousness-type double patenting over:

Copending Application No. 2006/0078825, Filed November 7, 2005;

Copending Application No. 2004/0038080, Filed June 27, 2003;

Copending Application No. 2004/0202097, Filed April 5, 2004; and

Copending Application No. 2004/0152016, Filed December 30, 2003.

As noted by the Examiner, a terminal disclaimer may be used to overcome a provisional rejection based on a non-statutory double patenting. The applicants will consider filing a terminal disclaimer in the present application if one or more of these co-pending applications **issue** before the present application, and if the present application is still pending at that point. Otherwise, it is respectfully submitted that since none of these other co-pending applications has yet issued, the present application can be passed into allowance and issued without the filing of a terminal disclaimer. A terminal disclaimer may then be filed, if appropriate, in one or more of these other co-pending applications, based on the issuance of the present application.

Accordingly, it is kindly requested that the provisional obviousness-type double patenting rejection be withdrawn, and that the pending claims be allowed. The Examiner is kindly requested to telephone the undersigned attorney, if any of the co-pending applications have issued prior to the present application, so that the applicants may file a terminal disclaimer if appropriate to expedite prosecution. The Examiner is also encouraged to telephone the undersigned attorney if there are any lingering issues that can be expediently addressed via telephone.

IV. Information Disclosure Statement (IDS)

A fifth supplemental IDS, a form PTO-1449 having references listed thereon, the appropriate fee, and a copy of non-U.S. patent reference(s) are being submitted along with this amendment. A fourth supplemental IDS, a form PTO-1449 having references listed thereon, and the appropriate fee were also filed previously on June 2, 2006. The Examiner is kindly requested to enter and consider these fourth and fifth supplemental IDSs, and to include an initialed copy of their corresponding forms PTO-1449 along with the next communication, so as to confirm that the references listed therein have been considered.

V. Conclusion

Overall, none of the references singly or in any motivated combination disclose, teach, or suggest what is recited in the independent claims. Thus, given the above amendments

and accompanying remarks, the independent claims are now in condition for allowance. The dependent claims that depend directly or indirectly on these independent claims are likewise allowable based on at least the same reasons and based on the recitations contained in each dependent claim.

If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to the allowability of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 622-4900.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

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